

Rejection Of Claims Under 35 U.S.C. 112

Sections 1 through 6 of the Office Action are identical to sections 4 through 9 of the prior office action. At section 5 of the Office Action, claims 1, 3-16, 18-30, 32-41, 43-45 and 47 were rejected under 35 U.S.C. 112, and sections 6 through 9 are intended to support that rejection. In the Office Action, it is argued that the claims include subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Specifically, it was argued in the Office Action that the application does not adequately describe how an electronic source document, that is available on a network of computers, would be analyzed in order to determine a referenced entity or a corresponding identifier in the electronic source document from the remainder of the electronic source document.

Previously,² applicant argued that:

- 1) a person skilled in the art of computers would know how to cause a computer to analyze an electronic source document to determine a referenced entity identified in the document, and
- (2) at page 4 of the application, an example of the invention is provided, and at page 4, lines 1-3 it states, "the invention scans a document, and matches it against a database of known individuals and organizations." One having skill in the art of computers would know from this

² See Applicant's response dated October 6, 2005.

description at least one manner of causing a computer to analyze an electronic source document to determine a referenced entity identified in the document.

In response, it was argued in the Office Action at section 9 that "the specification fails to teach how a system would scan an electronic source document available on a network, without downloading the document onto the user's system and identifying types of reference entity information the system should scan for...." The Office Action continues at section 10 where it was argued that "it would not have been obvious to one of ordinary skill in the art at the time the invention was made to know how to scan every letter/word/number of a *networked document* in order to determine an entity, and compare the entity to a stored database of entities."³

It appears there has been a misreading of the claims. There is no limitation in the claims which states "without downloading the document onto the user's system and identifying types of reference entity information the system should scan for" It is respectfully requested that limitations not be added to the claims in order to support a rejection of the claims.

The statement that ends section 9 of the Office Action and begins "without downloading the document ...", suggests the phrase "available on a network of computers" has been interpreted in the Office Action as indicating *where* analyzing occurs. Contrary to the interpretation set forth in the Office Action, the phrase

³ The standard set forth in section 10 of the Office Action is not the proper standard for a rejection under 35 U.S.C. 112. It appears the standard for a 35 U.S.C. 103 rejection has been improperly used.

"available on a network of computers" modifies the word "document". The claims say nothing about where the source document is analyzed. Furthermore, the claims do not exclude the possibility of downloading the document onto the user's system.

In addition, the arguments presented at section 9 of the Office Action indicate the claims are being interpreted in the Office Action to require that the system not identify types of reference entity information that the system should scan for. The claims do not have such a limitation. It is not clear from the Office Action why such a limitation was added to the claims in order to support a 35 U.S.C. 112 rejection of the claims.

Furthermore, the application discloses a method that includes matching against a database of known individuals and organizations. Also, the application discloses a method that includes examining the context of the article to establish the points of contact within an entity that the reader or viewer most likely wishes to contact, as well as entities that are not explicitly referenced in the document but may have substantive bearing on the issues discussed in the document. Therefore, there are examples given in the application in which analysis of the document is accomplished by identifying reference entity information that the system should scan for, and so the interpretation of the claims given in section 9 of the Office Action is at odds with the application.

If the Examiner continues to believe that the claims should be rejected under 35 U.S.C. 112 on grounds that the application does not enable one having skill in the art to make and use the invention because such a person would not (1) know how to use a

computer to analyze an electronic source document available on a network of computers to determine a referenced entity, or (2) such a person would not know how to scan every letter/word/number of such a document, then the Examiner is directed to page 14, line 15 of the application, page 12, line 20 of the application, and the documents cited in the Information Disclosure Statement.

For the reasons set forth above, it is respectfully requested that the 35 U.S.C. 112 rejection withdrawn.

Comments At Section 8 Of The Office Action

The Office Action states at section 8 that the undersigned argued that it would have been obvious to one of ordinary skill in the art at the time of the invention to know how to cause a computer to analyze an electronic source document to determine a referenced entity identified in the document. It is respectfully submitted that no such argument was made.

Instead, the undersigned argued that "a person skilled in the art of computers would know how to cause a computer to analyze an electronic source document to determine a referenced entity identified in the document." In making this argument, the undersigned was responding to a 35 U.S.C. 112 rejection, and was attempting to paraphrase the standard that is applicable under 35 U.S.C. 112. However, in paraphrasing 35 U.S.C. 112, the undersigned did not use the phrase "obvious to one of ordinary skill". The standard under 35 U.S.C. 112 and that cited in the Office Action at section 8 are not the same, and in many instances are not similar. Applicant objects to the misstatement that constitutes section 8 of the Office Action.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted a full and complete response to the Office Action has been made. The claims are in condition for allowance, and allowance of the claims is respectfully requested.

The Applicant believes that no fee is due with this Response. If a fee is due, please charge Deposit Account No. 08-2442. Further, Applicant believes that no extension of time is necessary to file this Response. However, if an extension of time is needed, please consider this as a petition for an extension of time necessary to enter this Response.

The Examiner is invited to call applicant's attorney if any questions remain following review of this response. If it will help, the undersigned is willing to explain by telephone or in person, the reasons the claims are allowable.

Respectfully submitted,



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